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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PHAM, CHRYSTINE

ART UNIT	PAPER NUMBER
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2122

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,845

Applicant(s)

MATENA ET AL.

Examiner

Chrystine Pham

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 15 March 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13 are drawn to an invention for upgrading a Java application, classified in class 717, subclasses 168-178.
 - II. Claims 14-21 are drawn to an invention for upgrading a platform, classified in class 717, subclass 168-178; class 709, subclass 220+; class 713, subclass 100.

During a telephone conversation with Albert S. Penilla (Reg. No. 39487) on May 19th, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because:
 - o They do not include the following reference sign(s) mentioned in the description:
14 (Fig.10B -- pg.25 line 11), 2001 (Fig.20 -- pg.37 line 9), 2002 (Fig.20 --pg.37 line 12), 2003 (Fig.20 -- pg.37 line 13), 2004 (Fig.20 -- pg.37 line 14), 2005 (Fig.20 -- pg.37 line 17), 2006 (Fig.20 -- pg.37 line 17), 210 (Fig.21 -- pg.38 line

11), 2104 (Fig.21 -- pg.40 line 4), 2105 (Fig.21 -- pg.40 line 5), and 2109 (Fig.21 -
- pg.40 line12).

- o They include the following reference sign(s) not mentioned in the description:
1007 (Fig.10B), 1715 (Fig.17), Fig.7, and Fig.15.

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show operations **as described** in the specification. For example, operation 1008[:load executive's class files] (see Fig.10B) labels an arrow, which starts from rootJ2eeServer 1052 and ends at repository 606. However, the specification states that "The Root J2EE Server 1052 then starts the root system application by allocating the control module, which is the module implementing the executive 210, in operation 1008." (pg.24 line 16-18). Operation 1008 as depicted in Fig.10B deviates from its description in the specification. Similar issues are present in operations 1009 (pg.24 line 18-19), 1010 (pg.24 line 20-21), 1011 (pg.24 line 22-23), 1017 (pg.25 line 16-17), 1410 (pg.29 line 14-16), 1411 (pg.29 line 16-17), and 1416 (pg.30 line 2-3). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).
4. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: cross-reference to related applications does not contain updated status of the applications (application numbers); incomplete sentence (pg.18 line 9); inconsistency between description of the "old J2EE Server 502b" in the specification (pg.36 line 19) and "newJ2eeServer 502b" in drawing Fig.19, and

misspelling of word "policies" (e.g., pg.6 line 9 and pg.42 line 5). Appropriate correction is required.

6. The use of the trademark JAVA has been noted in this application (e.g., claims 1, 8-19, and 21). It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 101

Double Patenting

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-13 of copending Application No. 09846067 (hereinafter *copending application*). Although the conflicting claims are not identical, they are not patentably distinct from each other because the two sets of claims are directed to a method for performing an online upgrade of a Java application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As per claim 1, the *copending application* claims a method performing an online upgrade to a Java application (see claim 8 line 1-2), the method comprising:

- Executing an application having an original service module (see *original entity bean*, claim 8 line 3) and an original control module (see *original state object*, claim 8 line 3-4), wherein the original control module includes application-specific policies for the application (see *state of original entity bean*, claim 8 line 5).
- Generating an upgraded control module (see *upgraded state object*, claim 8 line 9).
- Creating an upgraded service module (see *upgraded entity bean*, claim 10 line 1) using the upgraded control module, whereby the original control module and the original service module are upgraded (claim 10 line 1-2).

As per claim 2, the *copending application* claims a method as applied to claim 1, wherein the upgraded control module is generated using upgraded class files for the upgraded control module loaded from a system repository (claim 8 line 7-10).

As per claim 3, the *copending application* claims a repository having upgraded class files for the original service module and upgraded class files for the original control module (see *original entity bean & original state object*, claim 8 line 7-8) wherein the original control module is

upgraded by generating an upgraded control module using upgraded class files from the repository (see claim 8 line 9-10). It would have been obvious to one of ordinary skill in the pertinent art to use the claims set forth in the *copending application* to further generate an upgraded service module using upgraded class files for the upgraded service module loaded from the repository.

As per claim 4, the *copending application* claims a method as applied to claim 3, further comprising the operation of disabling requests to the original service module (claim 11 line 1-2).

As per claim 5, the *copending application* claims a Java platform wherein functionality of the Java module is not disrupted when the upgraded control module (see *upgraded state object*, claim 13 line 2) is generated. Since the Java module can be mapped into a Java application which also contains a service module, the generation of the upgraded control module entails the generation of the upgraded service module (see *state object, state management, and entity bean*, claim 8 line 5-6). Furthermore, the functionality of the Java module, which not to be disrupted, implies continuous administration of service, which in turn implies the enabling of requests to the upgraded service module.

As per claim 6, the *copending application* claims a method of upgrading a Java application (claim 8) wherein the upgraded control module is generated using upgraded class files from the repository, and transferring the application-specific policies to the upgraded control module (see *upgraded state object, and state*, claim 8 line 9-11). Since the upgrading of the Java application is induced by the upgrading of the control module. It would have been obvious to one of ordinary skill in the pertinent art that the upgrading of child application will reflect that of the parent application, that is to say, the operation of upgrading the child application uses the upgraded control module of the parent application.

As per claim 7, the *copending application* claims a method as applied to claim 6, further comprising the operation of passing the application-specific policies to a control module of the child application (claim 8 line 10-11).

As per claim 8, the *copending application* claims a Java platform capable of performing online software upgrades (claim 8 line 1-2), the Java platform comprising:

- An application having an original service module and an original control module (see *original entity bean and original state object*, claim 8 line 3-5) , wherein the original control module includes application-specific policies for the application (see *state of original entity bean*, claim 8 line 5).
- A repository having upgraded class files for the original control module and upgraded class files for the original service module (claim 8 line 7-8).
- Wherein the original control module is upgraded by generating an upgraded control module using the upgraded class files for the original control module loaded from the repository, and wherein the original service module is upgraded by creating an upgraded service module using the upgraded control module (claim 8 line 9-11).

As for claims 9-13, the *copending application* also recites limitations which have been addressed respectively in claims 3-7 from above.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ma et al. (U.S. Patent 5,920,725) of record, hereinafter *Ma et al.*

As per claim 1, *Ma et al.* teach a method for performing an online upgrade to a distributed-object application (e.g., see Abstract), the method comprising:

- Executing an application having an original service module and an original control module (e.g., FIG.5, FIG.6), wherein the original control module includes application-specific policies for the application (e.g., see FIG.5 rules 81, col.8 line 37-39).
- Generating an upgraded control module (e.g., col.8 line 55, FIG.3 classes 68', 68 & associated text).
- Creating an upgraded service module using the upgraded control module, whereby the original control module and the original service module are upgraded (e.g., FIG.8, col.8 line 20-34).

As per claim 2, *Ma et al.* teach a method as applied to claim 1, wherein the upgraded control module is generated using upgraded class files for the upgraded control module loaded from a system repository (e.g., see FIG.3 repository 62 and associated text, col.4 line 42-48).

As per claim 3, *Ma et al.* teach a method as applied to claim 1, wherein the upgraded service module is generated using upgraded class files for the upgraded service module loaded from a system repository (e.g., see FIG.3 repository 62 and associated text, col.4 line 42-54).

As per claim 4, *Ma et al.* teach a method as applied to claim 3, further comprising the operation of disabling requests to the original service module (e.g., see FIG.4 step 59 & 60, col.4 line 59-62, col.5 line 17-21, col.7 line 50-51, col.10 line 49-50).

As per claim 5, *Ma et al.* teach a method as applied to claim 4, further comprising the operation of enabling requests to the upgraded service module (e.g., col.7 line 41-43, col.10 line 55-56).

As per claim 6, *Ma et al.* teach a method as applied to claim 1, further comprising the operation of upgrading a child application using the upgraded control module (e.g., col.7 line 19-39 and line 46-48).

As per claim 7, *Ma et al.* teach a method as applied to claim 6, further comprising the operation of passing the application-specific policies to a control module of a child application (e.g., col.9 line 20-27, col.11 line 25-40).

As per claim 8, *Ma et al.* disclose a platform capable of performing online software upgrades, the platform comprising:

- An application having an original service module and an original control module (e.g., FIG.5, FIG.6), wherein the original control module includes application-specific policies for the application (e.g., col.8 line 37-39).
- A repository having upgraded class files for the original control module and upgraded class files for the original service module (e.g., see FIG.3 repository 62 and associated text, col.4 line 42-48).
- Wherein the original control module is upgraded by generating an upgraded control module using the upgraded class files for the original control module loaded from the repository (e.g., see FIG.3 repository 62 and associated text, col.4 line 42-48), and wherein the original service module is upgraded by creating an upgraded service module using the upgraded control module (e.g., see FIG.8).

As for claims 9, *Ma et al.* disclose a platform as applied to claim 8, wherein the upgraded service module is generated using upgraded class files for the original service module loaded from the repository (e.g., col.4 line 45-48, col.6 line 12-15).

As per claim 10, *Ma et al.* disclose a platform as applied to claim 9, wherein requests to the original service modules are disabled during upgrade of the original service module (e.g., see Abstract and also col.11 line 49-55).

As per claim 11, *Ma et al.* disclose a platform as applied to claim 10, wherein requests to the upgraded service module are enabled during upgrade of the original service module (e.g., see Abstract and also col.4 line 59-63).

As per claim 12, *Ma et al.* disclose a platform as applied to claim 8, wherein the upgraded control module is capable of initiating the upgrade of a child application (e.g., col.6 line 19-23, col.9 line 20-22).

As per claim 13, *Ma et al.* disclose a platform as applied to claim 12, wherein the application-specific polices are passed to a control module of the child application during the upgrade of a child application (e.g., col.9 line 24-33, col.11 line 25-40).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - o Method for instantiating a class having different versions, Reich et al. (U.S. Patent 6,175,855).
 - o Systems and methods for automatic application version upgrading and maintenance, Heath et al. (U.S. Patent 6,006,034).


- o System and method for automatically modifying database access methods to insert database object handling instructions, Tock et al. (U.S. Patent 6,128,771).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chrystine Pham whose telephone number is 703.605.1219. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on 703.305.4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chrystine Pham
Examiner
Art Unit 2122



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